REMARKS

Reconsideration and withdrawal of the rejections of the claimed invention is respectfully requested in view of the amendments, remarks and enclosures herewith, which place the application in condition for allowance.

I. STATUS OF CLAIMS AND FORMAL MATTERS

Claims 1-17 are pending in this application. Claims 1-8 are currently under examination and claims 9-17 are withdrawn from consideration. The primary amendment made to the claim is the insertion of the limitation of original claim 3 into claim 1 with respect to the substitution pattern on the phenyl moiety (now 1, 2, 4-substitution pattern). No new matter has been added by this amendment.

It is submitted that the claims, herewith and as originally presented, are patentably distinct over the prior art cited in the Office Action, and that these claims were in full compliance with the requirements of 35 U.S.C. § 112. The amendments of the claims, as presented herein, are not made for purposes of patentability within the meaning of 35 U.S.C. §§§§ 101, 102, 103 or 112. Rather, these amendments and additions are made simply for clarification and to round out the scope of protection to which Applicants are entitled.

II. THE 35 U.S.C. 112, 2nd PARAGRAPH REJECTION HAS BEEN OVERCOME

Claims 1-8 were rejected as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regards as the invention. The applicants request reconsideration of this rejection for the following reasons.

The rejections made in paragraphs 1-3 have been addressed with the amendments made above. However, the applicants are uncertain as to what is unclear about claim 8. The term "N-heteroaromatic" is well-known to those of skill in the art and refers to nitrogen containing heterocycles which are also aromatic compounds. Likewise, it is incorrect that claim 8 fails to further limit claim 7, i.e. claim 7 requires the preparation of the isocyanate (V) is carried out in the presence of an aprotic polar solvent at a temperature of from -30°C to 70°C and is optionally carried out in the presence of an N-heteroaromatic compound; claim 8 makes it a requirement that the process is carried out in the presence of an N-heteroaromatic compound.

III. THE 35 U.S.C. 103(a) REJECTION HAS BEEN OVERCOME

Claims 1-8 were rejected as allegedly being obvious by Vermehren et al., DE 199 46 341 (U.S. Patent 7,026,477 is the parallel English language application) in view of Stubbs, *American*

Chemical Journal, 50, 193-204, 1913. The applicants request reconsideration of this rejection for the following reasons.

Establishing a holding of *prima facie* obviousness requires that all claim limitations must be taught. As noted in the Office Action, the Vermehren reference does not teach the process step of forming the compound of formula (III) by reacting the compound of formula (II) with a compound of formula R-Q-H. (In order to expedite prosecution, the compound of formula (II) is now the compound of formula (IIa) previously described in original claim 3 – this phenyl moiety has a 1, 2, 4-substitution pattern).[1]

Furthermore, since Vermehren does not disclose this process step, it also does not teach that the reaction with the compound of formula R-Q-H is selective for Hal^2 and not Hal^1.

To address this deficiency, Vermehren is combined with the teachings of Stubbs. However, Stubbs is not relevant to the claims as amended.

Stubbs discloses sulfobenzoic acids which have *nitro* substitution in which the position of the nitro substituent has *not been specified* (see e.g. page 203, line 2 which refers to the position of the sulfonyl group, but not the nitro group). If Stubbs was relied upon for the reference to Noyes on page 202, the *nitro* group was in a position which was para to the carboxyl group and is not relevant to the present invention. The only formula in which the position of the nitro group is actually shown, i.e. page 204, it is in the "wrong" position; the 5-position rather than the 4-position.

As such, Stubbs does not remedy the deficiency of Vermehren because the definition of X* in the applicants' claims is limited to hydrogen or halogen and the 1, 2, 4-substitution pattern has not been disclosed.

Additionally, even if Stubbs had been more suitable for combination with Vermehren, it still would not teach or suggest the selectivity of the reaction for Hal^2 instead of Hal^1.

[1] The applicants reserve the right to pursue the scope of the originally filed claims in a continuation or divisional application,

Therefore, as all of the applicants' claim limitations has not been taught by the combination of Vermehren and Stubbs, there is no basis for a holding of obviousness and this rejection can be withdrawn.

IV. THE OBVIOUSNESS-TYPE DOUBLE PATENTING REJECTION HAS BEEN OVERCOME

Claims 1-8 have been provisionally rejected under obviousness-type double patenting over claims 1-20 of Vermehren et al. (U.S. Patent 7,026,477 – "Vermehren '477") in view of Stubbs, *ibid.*

For the reasons given above, the Vermehren reference does not render the applicants' claimed invention obvious. In addition, for the purposes of obviousness-type double patenting, the provisional rejection of the applicants' claims in view of Vermehren and Stubbs is made in error.

While there are certain similarities to the analysis, the standard for determining obviousness-type double patenting is not the same as the standard for determining obviousness. In the former, the analysis is limited to a comparison of the applicants' claims and the claims of the cited patent and the specification of the cited patent cannot be used as prior art. *See MPEP 804*. The patent specification and/or secondary references are permitted only for clarification or informative purposes (e.g. use as a dictionary to determine the meaning of a term); not to remedy deficiencies of the cited patent claims. As such, the reliance on Stubbs is *prima facie* evidence that the applicants' claims are not obvious for the purposes of obviousness-type double patenting over Vermehren.

CONCLUSION

In view of the remarks and amendments herewith, the application is believed to be in condition for allowance. Favorable reconsideration of the application and prompt issuance of a Notice of Allowance are earnestly solicited. The undersigned looks forward to hearing favorably from the Examiner at an early date, and, the Examiner is invited to telephonically contact the undersigned to advance prosecution. The Commission is authorized to charge any fee occasioned by this paper, or credit any overpayment of such fees, to Deposit Account No. 50-0320.

Respectfully submitted,
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